

REMARKS/ARGUMENTS

Claims 5, 12, 20, 21-25 and 26-36 are active. The mixtures of two ingredients (B2) in the present claims find support in the section bridging pages 12-13 and bridging pages 14-15 of the specification. The viscosity limitations in claims 12 and 26 find support on page 17, lines 5-6 of the specification. Claim 12 has been revised to expressly indicate that the wt% of ingredients (B1) and (B2) is based on the weight of the liquid skin protective composition as disclosed on page 14, line 14 and page 16, line 8 of the specification. New claim 26 tracks the claim 14, but has been revised to omit intended use limitations from the description of the composition and for conciseness; an HLB not more than 6 (or for claim 27, HLB of 4) finds support in the last full paragraph on page 9 of the specification. Claim 28 finds support in the last two lines of page 8; claim 29 on page 14, lines 8-9; and claim 30 (and amended claim 22) in the middle of page 15. The ratios in claim 31 appear in the middle of page 17, the monovalent alcohol content of claim 32 on page 18, lines 4-6, and the freedom from pigment or inorganic powder of claim 33 on page 20, line 10. The anti-inflammatory or anti-microbial ingredients of claims 34-35 are described on pages 18-20 of the specification. No new matter has been introduced. Favorable consideration of this amendment in light of the remarks below and allowance of the case are respectfully requested.

Rejection—35 U.S.C. §112, second paragraph

Claims 12 and 20-25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite with regard to the weight percentages (wt.%) of ingredients (B1) and (B2). Independent claim 12 has been amended to expressly indicate that the wt%'s are based on the weight of the liquid skin care composition. Therefore, this rejection may now be withdrawn.

Rejection—35 U.S.C. §103(a)

Claims 12, 20 and 23-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyagi, JP 07-277923, in view of Ziemelis, et al., U.S. 4,472,566. This rejection cannot be sustained because, in addition to the reasons set forth in the prior arguments, the cited art does not disclose, suggest or provide a reasonable expectation of success for a composition in which **(B2)** contains methylpolysiloxane and liquid paraffin having a volatility of not more than 0.1 mg.cm²hr and a mutual solubility of 10% or less. The specification at the top of page 15 discloses the superior functionality imparted by this combination which permits the (B2) ingredients to phase separate after evaporation of the more volatile ingredient (B1). These properties include producing a post-application non-sticky feel after the volatile (B1) ingredient evaporates and providing superior lubricity.

The attached Declaration further demonstrates the superior properties of compositions containing the two phase-separating ingredients (B2): methylpolysiloxane and liquid paraffin. Supplemental Examples 1 and 2 in the Declaration respectively show that compositions containing 50 wt% (25 + 25) or 30 wt% (15+15) of these ingredients, exhibited superior properties compared to Supplemental Comparative Examples 1 and 2 which contained 64 wt% or 6 wt% of ingredients (B2), and which both fall outside the (B2) content range of 30-60 wt.%. Examples 6 and 7 in Table 1 of the specification are also comparable, each containing similar ingredients and a (B2) at 40 wt.%. These results show that too high a (B2) content (Comp. Ex. 1) results in separation of the ingredients, thus making it impossible to determine the cosmetic properties of the integral composition. Too low a content of (B2) (Comp. Ex. 2) results in significant increases in friction coefficient and deterioration in good skin feel and protective properties after application. The Applicants reiterate their prior arguments below.

Aoyagi does not disclose or suggest a method of spraying a liquid formulation containing the particular ingredients required by independent claim 12, nor does it suggest a way to effectively interblend ingredients B-1, two ingredients B-2, and A. The lipstick and foundation referred to at page 4, line 15 of the OA are solid or powder formulations and cannot suggest the sprayable liquid formulation of the invention.

While the secondary reference, Zemelis, col. 6, line 62 *ff.* discloses various means of applying a cosmetic product to the body, “such as wiping, rubbing or spraying” (OA, page 4, line 17), it too does not suggest spraying a liquid formulation of ingredients B-1, B-2 and A.

In the section bridging pages 4 and 5 of the OA, the Examiner asserts that the “amount of a specific ingredient” is a results-effective parameter “to best achieve the desired results”. However, the prior art does not disclose that selection of the particular ingredients (B2) having different mutual solubilities and providing phase separation after application and evaporation of volatile ingredient (B1) are results-effective variables for the superior lubricity and non-sticky properties provided by the invention.

Based on the Examiners reliance on prior art disclosure of non-sprayable lipstick and foundation compositions, the rejection implies that one of ordinary skill in the art would have thought it desirable to reformulate lipstick and foundation to be sprayable products by varying the amounts of the specific ingredients in the prior art lipstick or foundation products. However, Aoyagi does not suggest or provide any motivation for such a reformulation of lipstick or foundation. On its face, it doesn’t make sense to reformulate a lipstick or a foundation as a sprayable skin care product because these products have recognized modes of application which are incompatible and significantly different than the sprayable composition of the invention, now, even more so in view of the requirement for careful selection of the two (B2) ingredients providing phase separation and improved lubricity after application to the skin. These properties and ingredients are not disclosed or suggested by the prior art.

Along these lines, the Official Action does not point out any motivation for selecting the particular ingredients B-1, two ingredients B-2, and A for use in a liquid formulation (in distinction to all of the other “essential components” described by lines 3-4 on page 9 of the English translation of Aoyagi). However, the general rationale appears to be that ingredients B-1, B-2 and A were all known in the prior art and that it would have been obvious to combine them in a sprayable liquid formulation. Based on this view, it would have been *prima facie* obvious to mix and match any or all of the various ingredients disclosed by Aoyagi. However, such indiscriminate and random matching would not have resulted in the identification of the superior skin care method of the invention. These random combinations represent a huge genus of different products, including solid products like lipstick or dry products like foundation. Such a generic rationale ignores the specific required selections of ingredients and amounts of ingredients of the invention, as well as the superior properties provided by making these selections and choosing the required content ranges. These advantages include superior sprayability and initial spreadability provided by selection of volatile ingredient B-1, superior water-resistance and lubricity provided by ingredient B-2 and the protective effects imparted by ingredient A. Moreover, as discussed above the specific selection of two ingredients (B2) methylpolysiloxane and liquid paraffin having a volatility of not more than $0.1 \text{ mg} \cdot \text{cm}^2/\text{hr}$ and a mutual solubility of 10% or less provides additional superior and surprising functionality due to the ability of these ingredients to phase separate after evaporation of volatile ingredient (B1).

The prior art neither suggests nor provides a reasonable expectation of success for a sprayable composition having these properties and it does not describe any results-effective variable for achieving them. “Only results-effective parameters can be optimized”, MPEP 2144.05(II)(B). A results-effective variable is one that achieved a recognized result. Here, the Examiner has not pointed out any results-effective variable for achieving the superior

properties provided by the invention. These superior properties were pointed out on page 8 of the Applicants' last response, but have not been specifically addressed by the recent OA, thus they remain unrebutted.

While the Examiner refers to results-effective variables for making a sprayable composition (e.g., selecting the amount of an ingredient or its viscosity) instead of a solid lipstick or foundation, these variables are not those necessary to provide a sprayable composition also having the superior properties of mixture of B-1, the two ingredients B-2, and A in the amounts required by claim 12. No results-effective variable been identified within the prior art that provides a composition having these superior properties. Moreover, no motivation has been pointed out in the prior art for selecting the combination of B-1, the two ingredients B-2 and A instead of some other combination of ingredients which do not provide the superior properties of the invention. Accordingly, this rejection cannot be sustained.

Rejection—35 U.S.C. §103(a)

Claims 12 and 20-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyagi, JP 07-277923, in view of Nakanishi, et al., U.S. 2002/0131947 and International Cosmetic Ingredient Dictionary and Handbook, 7th edition. This art, like that applied above, does not disclose, suggest or provide a reasonable expectation of success for a composition in which (B2) contains methylpolysiloxane and liquid paraffin having a volatility of not more than 0.1 mg.cm²hr and a mutual solubility of 10% or less. The superior functionality imparted by this combination in which these (B2) ingredients phase separate after evaporation of the more volatile ingredient (B1) is disclosed at the top of page 15 of the specification. Therefore, for reasons similar to those discussed above, this rejection cannot be sustained.

Furthermore, Aoyagi does not suggest the selection of the particular ingredients B-1, B-2 and A in the amounts required to provide a superior method involving spraying a composition containing a low volatility ingredient B-1 in combination with B-2 and A which provide water-resistance and persistent skin protection.

The two secondary references are also silent, not suggesting or providing a reasonable expectation of success for the combination of elements required to practice the claimed method. Nakanshi was applied (see the OA, bottom of page 6) as disclosing sprayable oil-based cosmetics containing modified silicones. The ICIDH was relied upon for describing emollients for skin such as cyclomethicones that retard evaporation of water from the surface of the skin.

The Examiner states in the center of page 7 of the OA, that these references in combination provide motivation for making a stable, adhesive and sprayable skin care product that is not sticky. However, this section does not explain why the specific ingredients required by the present claims in the amounts specified (including the low amount of water) would provide a stable, adhesive and sprayable composition. Nor does it suggest the selection of the two ingredients (B2) would provide any benefit.

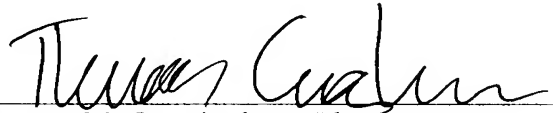
Moreover, no results-effective variables are pointed out in the prior art for the selection of the volatile (B1) component of the invention in combination with the relatively non-volatile (B2) component and protective component (A). No support is pointed out for limiting water content in the recited sprayable compositions to 10 wt.% or less. Therefore, for all of these reasons this rejection cannot be sustained.

Conclusion

In view of the amendments and remarks above, the Applicants respectfully submit that this application is now in condition for allowance. An early notice to that effect is earnestly solicited.

Respectfully submitted,

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